

REMARKS

Claims 1 and 2 are pending in the application.

Claims 1 and 2 are rejected under 35 U.S.C. 112

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyokawa et al. (5,289,263) in view of Mimura et al. (5,880,816).

The Applicants traverse the rejections and request reconsideration.

Claim Rejections Under 35 U.S.C. § 112

The Applicants respectfully reiterate that paragraph [043] of the Specification clearly supports the limitation that **the apparatus is operable to sequentially load data without stopping the motor.**

Although the specification does not use exactly the same terms as in the claims, there is no requirement that the subject matter be described in the specification in an *in haec verba*—i.e., word for word—manner. “[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.” *In re Barker*, 559 F.2d 588, 592 n.4, (CCPA 1977). In essence, the “written description” requirement requires that each and every element in the claims be adequately described in the Specification to show one of skill in the art that the inventor was in possession of the invention at the time the application was filed. *See Manual Of Patent Examining Procedure* (“MPEP”) § 2163.02. Further, “all that is necessary to satisfy the description requirement is to show that one is ‘in possession’ of the invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d

1555 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of the invention by describing the invention, with all of its claim limitations.” *Id.*

However, it is well settled that “[i]t is not necessary that the claimed subject matter **be described identically**, but the disclosure originally filed must convey to those skilled in the art that the applicant has invented the subject matter claimed.” *In re Wilder*, 736 F.2d 1516, 1520 (Fed. Cir. 1984) (citation omitted). Indeed, “[i]n order to satisfy the written description requirement, the disclosure as originally filed **does not have to provide in haec verba support** for the claimed subject matter at issue.” *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002); *See In re Werthheim*, 541 F.2d 257, 265 (CCPA 1976) (“Lack of literal support...is not enough...to support a rejection under § 112.”). Moreover, the “failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” *All Dental Prodx, LLC v. Advantage Dental Prods.*, 309 F.3d 774, 779 (Fed. Cir. 2002).

In the present case, paragraph [0043] clearly provides that the system controller 17 successively stores the wafer edge values thus received in memory 18. Further, paragraph [0043] provides that the system controller 17 repeats the same operations until the wafer makes one or more revolutions, thereby recording the outer peripheral data corresponding to one round of the wafer 1 in the memory 18. At least from this description, it is clear to a skilled artisan that the data is loaded sequentially without stopping the motor.

The Examiner is respectfully requested to withdraw the rejection based on section 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 103

Rejection of claims 1 and 2 under 35 U.S.C. 103(a) over Kiyokawa and Mimura

The Examiner has withdrawn the rejection purely based on Kiyokawa. However, the claims have been rejected based on the combined teachings of Kiyokawa and Mimura.

The Examiner appears to admit that Kiyokawa does not suggest the feature related to loading data without stopping the motor. However, the Examiner contends that it would have been obvious to substitute the pulse motor (of Kiyokawa) with a continuous motor (of Mimura) to achieve the allegedly predictable result of acquiring one of an orientation-flat position, notch position and center position of the wafer on the basis of the edge position detection with accuracy (see third full paragraph on page 4 of the Office Action).

Apart from the above assertion, the Examiner does not appear to have provided any support for the above discussed feature related to loading the data without stopping the motor. Clearly, the alleged teaching referred to by the Examiner has very little to do with loading the data without stopping the motor.

The Examiner is respectfully requested to show clearly where this feature is suggested in the prior art. Furthermore, the Examiner is respectfully requested to point out clearly as to why the allegedly predictable result of acquiring a position of the wafer also predicts the loading of the data as the Examiner appears to be alluding.

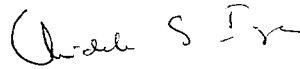
The Applicants respectfully submit that Mimura does not overcome the deficiency in Kiyokawa by disclosing or suggesting the loading of data without stopping the motor.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Chid S. Iyer
Registration No. 43,355

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: November 5, 2007